

Appl. No. 09/994,199

Amd. Dated July 19, 2004

Reply to Office Action Dated March 17, 2004

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Claims 1-38 remain in this application. Claims 1, 10, 14-15, 19, and 20-35 are amended herein.

Rejection(s) under 35 U.S.C § 102(b)

Claims 1-4, 7, 10, 11, 15, 16, 18, 20-23, 35, 36 and 38 are rejected under 35 U.S.C. § 102(b) as being anticipated by Abercrombie (US 4,605,065). Applicant respectfully traverses the rejection.

Each of Applicant's amended claims is directed to a formation evaluation tool with a coupon or material that is optically reactive to the presence of hydrogen sulfide. It is respectfully submitted that none of the art of record depicts such a feature. In contrast, Abercrombie relates to well tubing for producing a well. There is no disclosure in Abercrombie of a formation evaluation tool as recited in each of Applicant's claims.

In view of the above, Applicant submits that the over the art of record fails to anticipate Applicant's claims. Applicant, therefore, requests withdrawal of the rejection under 35 U.S.C. § 102.

Rejection(s) under 35 U.S.C § 103

Claims 5, 6, 8, 9, 12, 13, 14, 17, 19, 24-31, 32-34, and 37 are rejected under 35 U.S.C. § 103 as being obvious over Abercrombie (US 4,605,065) in combination with Waterman, GB 2344365, Williams, and/or Monel. Applicant respectfully traverses the rejection. The Examiner has failed to establish a prima facie case of obviousness based on the cited references.

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As discussed above, Abercrombie, the primary reference, relates to well tubing for producing a well and fails to teach a formation evaluation tool. The references of record fail to provide the deficiencies of Abercrombie. Like Abercrombie, Waterman, Williams and Monel each fail to even contemplate a formation evaluation tool with a coupon or material that is optically reactive to the presence of hydrogen sulfide as recited in Applicant's claims. It is respectfully submitted that none of the art of record (alone or in combination) depicts such a feature.

Moreover, there is no motivation to combine the cited references as suggested by the Examiner. Waterman teaches away from positioning a coupon within the flow of fluid for an interval of time as provided by Abercrombie. *See Waterman, col. 1, lines 31-48 and Abercrombie, col. 2, lines 30-38.* Thus, one of skill in the art would be deterred from combining the teachings of Waterman with the teachings of Abercrombie. There is also no motivation to combine Abercrombie with GB2344365. Abercrombie is a well production device and GB2344365 is a sampling tool. Absent improper hindsight reconstruction, one of skill in the art would not be motivated to combine such techniques. Thus, there is no basis for combining Abercrombie with Waterman or GB2344365.

For at least these reasons, Applicant respectfully submits the art of record fails to anticipate or render obvious any of Applicants' Claims. Moreover, Applicant respectfully submits that none of the art of record teaches, discloses or even suggests Applicant's claimed invention. Applicant, therefore, requests withdrawal of the rejection Applicant's Claims under 35 U.S.C. §§ 102 and/or 103 based on the cited art and allow Applicant's claims.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicant believes this reply to be fully responsive to all outstanding issues and place this

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application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

This paper is submitted in response to the Office Action dated March 17, 2004 for which the three-month date for response is June 17, 2004. Pursuant to 37 C.F.R. § 1.136(a), Applicants petition for an extension of time of one month in which to respond to the Office Action. This one-month extension will bring the deadline for response to July 19, 2004, which is within the six-month statutory period (July 17 falls on a Saturday). The Commissioner is authorized to charge the fee of \$110.00 to Deposit Account No. 19-0610 for the one month extension. Please apply any charges not covered, or any credits, to Deposit Account 19-0610 (Reference Number 20.2756).

Date: 7/19/04

Respectfully submitted,

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